

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

WARSAW ORTHOPEDIC, INC.,
MEDTRONIC SOFAMOR DANEK
USA, INC., MEDTRONIC PUERTO
RICO OPERATIONS COMPANY,
and OSTEOTECH, INC.,

Plaintiffs,

vs.

NUVASIVE, INC.,

Defendant.

CASE NO. 12-cv-2738-CAB

ORDER GRANTING MOTION TO
STAY AND SETTING SCHEDULE

[Doc. No. 141]

Before the Court is a motion to stay brought by Warsaw Orthopedic, Inc., Medtronic Sofamor Danek U.S.A., Inc., Medtronic Puerto Rico Operations Co., and Osteotech, Inc. (hereinafter collectively “Warsaw”) with regard to U.S. Patent No. 8,444,696, asserted by Warsaw, and U.S. Patent Nos. 8,361,156; 8,187,334; 8,000,782; 8,005,535; 8,016,767; 8,192,356; and D652,922, asserted by NuVasive. [Doc. No. 141.] NuVasive filed a request for *inter partes* review (“IPR”) of the Warsaw patent, which has been granted. Warsaw filed requests for IPR of the NuVasive patents, which are still pending.

The Court considered the relevant factors in deciding whether a stay of this litigation as to these patents is appropriate. *See I-Flow Corp v. Apex Medical Techs,*

1 *Inc.*, 2008 WL 2078623, at *1 (S.D. Cal. April 15, 2008). The NuVasive patents are
2 all related. The IPR will likely simplify issues for trial. Although discovery has been
3 ongoing and the Court issued claim construction rulings on four of the NuVasive
4 patents, much remains to be completed including all the expert reports and discovery,
5 dispositive motion practice and trial preparation. No trial date has been set. Finally,
6 although the delay in proceeding with its case may be somewhat prejudicial to
7 NuVasive, it is not unduly prejudicial.

8 Having considered the submissions of the parties and the arguments of counsel,
9 for the reasons set forth on the record, the request for stay is granted on the following
10 conditions:


- 11 1. The litigation of U.S. Patent No. 8,444,696 is stayed pending the
12 completion of the IPR.
- 13 2. The litigation of U.S. Patent Nos. 8,361,156 and 8,187,334 is stayed until
14 February 28, 2014. The parties are directed to provide the Court with a
15 joint status report on or before February 28, 2014 regarding the PTO's
16 determination on the request for IPR as to these patents. All deadlines and
17 discovery as to these patents are vacated.
- 18 3. The litigation of U.S. Patent Nos. 8,000,782; 8,005,535; 8,016,767;
19 8,192,356; and D652,922 is stayed until May 2, 2014, with the exception
20 that the parties are directed to complete all outstanding fact discovery by
21 that date. The parties are directed to provide the Court with a joint status
22 report on or before May 5, 2014, regarding the PTO's determination on
23 the requests for IPR as to these patents. If all the asserted claims are
24 subject to review, the stay will continue until the completion of the IPRs.
25 NuVasive may request the stay be lifted if any asserted claims are not
26 subject to review and NuVasive seeks to proceed on those claims.

4. The litigation of U.S. Patent No. 5,676,146 will proceed on the following schedule:

- May 2, 2014 All fact discovery completed
- May 30, 2014 Opening expert reports served
- June 20, 2014 Rebuttal expert reports served
- July 18, 2014 Expert discovery completed
- August 8, 2014 Last day to file dispositive/Daubert motions
- October 24, 2014 File and serve Pretrial Disclosures FRCP 26(a)(3)
- October 31, 2014 Meet and confer to prepare Pretrial Order
- November 7, 2014 Warsaw provide draft Order to NuVasive
- November 14, 2014 Lodge final proposed Pretrial Order with Court
- November 21, 2014 Pretrial Conference (2:00 p.m.)
- December 1, 2014 Trial

IT IS SO ORDERED.

DATED: January 10, 2014


CATHY ANN BENCIVENGO
United States District Judge